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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09/905,519	07/13/2001	Satoshi Nakane	KON-1666	3475

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[REDACTED] EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
2873	

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/905,519	NAKANO, SATOSHI
Examiner	Art Unit	
Jordan M. Schwartz	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 06 May 2003.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-3,5-11,13,15,16,18,19 and 21-23 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 21-23 is/are allowed.
- 6) Claim(s) 1-3,5-11,13,15,16,18 and 19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e)(1).

**Attachment(s)**

- 1) Notice of References Cited (PTO-692)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-11, 13, 15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tucker patent number 6,102,539.

Tucker reads on these claims by disclosing the limitations therein including the following: an optical element (abstract) comprising a base material (column 2, lines 44 re either of "the lenses" as the base material); a surface layer formed on at least one of the surfaces (column 2, line 44 re "the adhesive" is between the lens elements and is therefore "formed on at least one of the surfaces" of the lenses and since it is formed on the surfaces of each of the lenses then it is a "surface layer"). Tucker further discloses that the adhesive layer includes a UV absorber to absorb substantially all radiation up to 400 nm (column 4, line 60) as well as the adhesive layer including a dye to provide selected transmission characteristics to reduce the transmission of light including the

lenses, if the lenses are not disclosed as absorbing radiation then the reflectance of the layer will

inherently be less than the reflectance of the base material surface, this being based upon it being disclosed that the layer absorbs and reduces light transmission in light ranges that include 280-315 (i.e. "substantially all radiation up to 400nm") and 420-680 nm. Tucker further discloses the lens in an eyeglass (abstract). Since the layer is an adhesive between two lenses (abstract) then, in reference to the most object side lens of the laminate, the adhesive is formed on an image side surface (eye side surface) of this lens. Furthermore, since it is an adhesive joining the two lenses then it will inherently be on the entire surface of this lens. The layered adhesive of Tucker would inherently include a substantially inorganic material, this being reasonably based upon Tucker disclosing that the layering can include a dye to impart the transmission characteristics (column 5, lines 11-37) and it is well known in the art of lenses that dyed lenses include the use of inorganic substances. It is believed that the adhesive of Tucker would inherently have the surface resistance as claimed, this being reasonably based upon the materials and method of forming the adhesive as set forth in Tucker. Tucker further discloses the lens including a polarizing film (column 5, lines 38-45). Therefore, the polarizing film can be considered the "base material" and it would be inherently providing the selective absorptivity as set forth in claims 8-9. Tucker further discloses the layering can have plural layers (column 2, lines 55-67); and that the layer can comprise a conductive or metallic layer (column 5, line 20).

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Belmares et

Belmares et al reads on this claim by disclosing the limitations therein including the following: an eyeglass comprising a lens (column 4, line 48) comprising a base material (column 4, line 48, the lens element as the base material); a surface layer formed on at least one of the surfaces (column 1, lines 10-14 re the coating on the lens surface); a lens holder (column 4, line 48 in that an eyeglass lens will inherently have a frame to hold the lens elements). Since the base material (the lenses) are not disclosed as absorbing radiation then the reflectance of a surface of the formed layer for all light rays in the wavelength region of 280 to 315 nm will inherently be smaller than a reflectance of a surface of the base material, this being based upon it being disclosed that the layer absorbs and reduces light transmission in the UV-B region (column 6, line 4). Belmares et al further discloses that the layer can be formed by spin coating or dip coating (column 6, line 63) in which case the entire lens would be layered and therefore the layer would inherently be "formed on an eye side entire surface of the (lens) base material".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable

Tucker discloses as is set forth above but discloses the adhesive on just one of the surfaces of the lens. However, it is well known in the art of polarizing lenses that such lenses can be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive. Having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the luminous properties and differences in wavelengths between the two surfaces as set forth in claims 16 and 18 since it is well known in the art of polarizing lenses that such lenses can be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive and having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18.

#### ***Prior Art Citations***

Austin patent number 5,332,618 is being cited herein to show another reference that would read on claim 19, however, such a rejection would have been repetitive. Specifically, the layering being formed on eyeglasses (column 1, line 6); the layering provides a reflectance in the visible light region smaller than that of the base material (column 5, line 28); and the layering formed on an eye side entire surface (column 3, line 19).

reference discloses an optical element coated on its image side surface with a layer that absorbs wavelengths below 480 nm (column 3, lines 13-57) and further discloses that it absorbs a little light in the 420-680 range (column 3, line 53). Even if the layer absorbs a little light in the 420-680 range then its reflectance will inherently be smaller than that of the base material.

***Allowable Subject Matter***

Claims 21-23 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to independent claim 21, none of the prior art either alone or in combination disclose or teach of the claimed optical element having a layer formed on at least one surface of a base material with the layer having the reflectance as claimed, the layer comprising a transparent conductive layer, and specifically further wherein the transparent conductive layer contains indium oxide. Specifically, with reference to independent claim 22, none of the prior art either alone or in combination disclose or teach of the claimed optical element having a layer formed on at least one surface of a base material with the layer having the reflectance as claimed, and specifically further wherein a luminous transmission of the layer is 90% or more. Specifically, with reference to claim 23, none of the prior art either alone or in

disclose or teach of the claimed optical element having a layer having the reflectance as claimed

and specifically further wherein a spectral transmission for all light rays in a wavelength region of 400 to 700 nm is 98% or more.

***Response to Arguments***

Applicant's arguments filed May 6, 2003 have been considered but, with respect to the rejected claims set forth above, they are not persuasive. Applicant argues that Tucker does not disclose the layer as a "surface layer". The examiner disagrees. The layering of Tucker is formed on the surfaces of each of the lenses that are being laminated together and can therefore be considered as a "surface layer" as to each of the lenses. Applicant has not claimed that the surface is one that is being exposed to the outside environment nor has applicant claimed that the image side entire surface of the lens is a surface that is exposed to the outside environment. Therefore the Tucker reference still reads on the claims as set forth above. In reference to independent claim 19, in addition to Tucker, Belmares and Austin still read on this claim.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

THE SHORTER OF:

AND A. (i) FILING A PETITION UNDER 37 CFR 1.136(b) OR (ii) PAYMENT OF THE THREE MONTHS shortened statutory period under the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
July 21, 2003